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Serial No.: 10004.801
Art Unit 1756

REMARKS

This Amendment is being filed in conjunction with an RCE and is responsive to the final Office Action, mailed March 28, 2003. Applicants have previously submitted an Amendment, mailed May 27, 2003, in response to the final Office Action. The May 27, 2003 Amendment was denied entry in an Advisory Action, mailed June 2, 2003. Applicants request that the Office disregard, and not make of record, the May 27, 2003 Amendment. In its stead, Applicants request the present Amendment be made of record.

The Office Action mailed March 28, 2003, has been carefully considered. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been introduced. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

Claim Status

Claims 1-17 are pending in this Application. By this Amendment, claims 1, 3, 7, 13, and 16 have been amended to more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. New claims 18-21 have been added. Claim 17 has been cancelled. Thus, the claims under consideration are believed to include claims 1-18 and 18-21. The specification has been amended on page 32, Table A, to reflect the proper negative charge to the values.

Claim Rejections Under 35 USC § 112, First Paragraph

Claims 1-18 stand rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Office is of the opinion that the specification as originally filed does not describe the invention as currently claimed. Specifically, the Office states that the specification does not disclose adding wax coated pigment granules to an electrophotographic

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toner or developer. Independent claim 1 has been amended to recite a method for coloring a composition which comprises the steps of adding wax coated pigment granules having a particular particle size and wax content to a binder resin to form a mixture, grinding the mixture and classifying the mixture. In view of this amendment, it is Applicant's belief that the specification describes the invention as currently claimed, in accordance with § 112, first paragraph.

Claim 17 stands rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 17 has been cancelled, thereby making this rejection moot.

In view of the foregoing, it is respectfully believed that the 35 USC § 112, first paragraph, rejections have been overcome.

Claim Rejection Under 35 USC § 112, Second Paragraph

Claims 1-16 stand rejected under 35 USC § 112, second paragraph, as being indefinite. Specifically, claims 1-16 stand indefinite as the Office believes that the elected species of electrophotographic toners and electrophotographic developers are not "compounds" as referenced in the claims. By this Amendment, Applicants have amended claim 1 to recite "A method for coloring a composition . . ." and have deleted all occurrences of the term "compound."

Claim 17 stands rejected as indefinite for the same reason as claims 1-16.

Claim 17 has been cancelled.

In view of the foregoing remarks and amendments, it is respectfully contended that the 35 USC § 112, second paragraph, rejections have been overcome.

Claim Rejections Under 35 USC § 103

Claim 17 stands rejected under 35 USC § 103(a) as being unpatentable over Pollard in US Patent 4,173,492 in view of *Handbook of Imaging Materials* to Diamond, pp. 182-171. This rejection is now moot as claim 17 has been cancelled.

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Claims 1-3, 5-10, and 12-16 stand rejected under 35 USC § 103(a) as being unpatentable over *Handbook of Imaging Materials* to Diamond, pp. 162-171 and 193-197 in view of Pollard in US Patent 4,173,492. This rejection is respectfully traversed.

It is Applicants' position that the Office has failed to establish a *prima facie* case of obviousness of claims 1-3, 5-10 and 12-16 as being unpatentable over Diamond in view of Pollard. The Office holds that "it would have been obvious to one having ordinary skill in the art . . . to use a wax coated pigment as the colorant in preparation of the conventional toner as discussed by Diamond, because Diamond teaches that dispersion of the colorant in a binder resin is a critical feature in toner manufacture," and Pollard teaches that wax-coated pigments have improved the dispersion in thermoplastic binder systems. Applicants respectfully can not agree with this conclusion.

The Office makes reference to the text of Diamond, p. 193, §4.6.1, where it is stated, "[p]igment and additive dispersion and particle size and size distribution are parameters that can strongly influence the quality of the resultant images. . . ." The Diamond reference, however, does not disclose how such variables affect toners and developers. On page 194, §4.6.2, Diamond states, "It is possible that an ultimate dispersion is not the most useful". Further, Diamond states "[t]he most effective dispersion of many xerographic additives is not well understood." Given these statements, the Diamond reference is, at best, equivocal regarding the impact of pigment and additive dispersion on the quality of the resultant toner or developer, and clearly denotes the lack of clear teaching confronting the ordinary artisan.

In consequence, one with ordinary skill in the art having a knowledge of both Diamond and Pollard, assuming, *arguendo*, that such artisan would combine the references, would at first be drawn into a state of uncertainty as to whether enhanced dispersion is desired given the teachings of Diamond. Such uncertainty would invariably extinguish any motivation the ordinary artisan has for combining the references as suggested by the Office.

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Section 103 demands that the prior art provide a reasonable expectation of success that the proposed modification will yield an improvement or advantage. Here, the reasonable expectation of success is lacking. An ordinary artisan with knowledge of Diamond draws no reasonable expectation that using wax coated pigment granules in electrophotographic toners or developers will result in any improvement or advantage. Furthermore, Pollard is silent concerning the use of wax coated pigment granules with electrophotographic toners and developers. Respectfully stated, it is Applicants' position that the Office has advanced a combination which the artisan may consider "obvious to try." An obvious to try rational, however, is not sufficient to maintain a rejection under § 103 and clearly suggests that the motivation necessary to arrive at Applicants' invention is gained by the use of impermissible hindsight.

For all the foregoing reasons, Applicants' invention, as defined by claims 1-3, 5-10 and 12-16 are not made obvious by Pollard in view of Diamond.

Reconsideration and withdrawal of the rejection is therefore courteously solicited.

Claims 10 and 11 stand rejected under 35 USC § 103(a) as being unpatentable over *Handbook of Imaging Materials* to Diamond, pp. 162-171 and 193-197 in view of Pollard in US Patent 4,173,492 as applied to claims 1-3, 5-9, 12, 13, 15 and 16 above, and further in view of Macholdt et al. In US Patent 6,159,849. For at least the foregoing reasons with respect to the 35 USC § 103(a) rejection of claims 1-3, 5-10, and 12-16, it is Applicants' position that claims 10 and 11 are not made obvious by any combination of the cited references.

In further support of the patentability of the claimed invention, Applicants' specification clearly provides evidence of unexpected results. On page 32, inventive examples 4, 5 and 6 show an increased charge constancy after 10 minutes activation, in contrast to comparative examples 7 and 8, which do not. The prior art certainly does not provide any indication that wax coated pigment granules would be expected to maintain a greater charge constancy as compared to uncoated pigment. This surprising technical advantage could not be foreseen, and constitutes further

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evidence of the patentability of the present invention, as defined by the claims, over the prior art of record.


In a copy of the Initialed 1449 form returned to applicant, the Office has indicated that two references were missing. In the Advisory Action mailed June 2, 2003, the Office states that such references have been considered, and requests Applicants file a new 1449 listing such references. Filed with this RCE and Amendment is an IDS, complete with a 1449 listing the two references, along with newly cited references and a European Search Report.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

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In view of the forgoing amendments and remarks, the present application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,


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